

REMARKS

At the time of the Fifth Office Action dated January 29, 2009, claims 9-16 were pending and rejected in this application. Claim 9 has been amended, and claims 36-45 have been added.

CLAIMS 9-14 AND 16 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON DIACAKIS, U.S. PATENT PUBLICATION NO. 2003/0174814 (HEREINAFTER DIACAKIS)

On pages 2-4 of the Fifth Office Action, the Examiner asserted that Yoakum identically discloses the claimed invention the claimed invention. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."³ During patent examination, the pending claims must be "given their broadest reasonable interpretation

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Medicchem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met.

Claim 9

Claim 9 recites that the method is performed within a telephone and that the telephone has a first connection to a packet switched network and a second connection to a circuit-switched telephone network. Claim 9 has also been amended to clarify that the first connection is separate from the second connection. On page 2 of the Fifth Office Action, the Examiner: (i) cited Fig. 1 of Diacakis; (ii) identified IP Network 16 as corresponding to the claimed packet switched network; and (iii) identified PSTN 14 as corresponding to the claimed circuit-switched telephone network. Referring to Fig. 1 of Diacakis, the telephone only has a single connection (not the multiple, different connections, as claimed). In fact, the telephone 8 does not have a connection with the IP Network 16. Instead, the telephone 8 only has a connection with the telephone network 14. Thus, Diacakis fails to identically disclose the claimed limitations.

⁴ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁶ See also, *Panduit Corp. v. Deminison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ *Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 9-14 and 16 under 35 U.S.C. § 102 for anticipation based upon Diacakis is not viable, and hence, Applicants solicit withdrawal thereof.

CLAIM 15 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON

DIACAKIS

On pages 4 and 5 of the Fifth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Diacakis to arrive at the claimed invention. This rejection is respectfully traversed.

The Examiner's analysis as to claim 15 is conclusory in nature is not based upon the teachings of the applied prior art. The Examiner has not set forth any common-sense rationale, supported by the teachings of the applied prior art, for making this modification. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claim 15 under 35 U.S.C. § 103 for anticipation based upon Diacakis.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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